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09/560,203

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Terry Erisman

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EXAMINER

FELTEN, DANIEL S

ART UNIT

PAPER NUMBER

3696

MAIL DATE

DELIVERY MODE

12/03/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte:* TERRY ERISMAN

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Application No. 09/560,203  
Technology Center 3600

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Mailed: December 3, 2008

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Before KRISTA ZELE *Deputy Chief Appeals Administrator*  
ZELE, *Deputy Chief Appeals Administrator*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on July 9, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

EXAMINER'S ANSWER, STATUS OF CLAIMS

A review of the file finds that the status of the claims as provided in the Examiner's Answer mailed January 16, 2008 under the heading "Status of Claims" is unclear and/or is not consistent with the status of claims of record in accordance with 37 C.F.R. § 41.37(c)(1)(iii). The status of the claims as provided in both the Examiner's Answer and the Appeal Brief must be consistent with the last entered amendment. Each claim on appeal must be identified. *See also Manual of Patent Examining Procedure* (MPEP) § 1205.02 (8<sup>th</sup> ed. Rev. 6, Sept 2007) for details.

A review of the file record does find a prior restriction requirement; however, the non-final Office action mailed January 27, 2006 implies that the restriction requirement was withdrawn inasmuch as all of claims 1-102 were treated on the merits (see paragraphs 1. and 2. on page 2 of the action).

The Brief filed October 3, 2007 only lists the "pending" claims but does not indicate if the claims which are not listed are 'withdrawn' or 'canceled'. A review of the Claim Appendix finds numerous claims listed as "cancelled"; however, a review of the file cannot find any entered amendment cancelling these claims.

A review of the Examiner's Answer "Status of Claims" section finds a statement that "the status of claims contained in the brief is correct"; whereas the "Grounds of Rejection" section of the Answer provides rejections for all claims 1-102.

Accordingly, a correction of the status of all claims is required.

CONCLUSION

Accordingly, it is ORDERED that the application is returned to the Examiner:

1) to notify appellant of a defective Brief and to require correction of the “Status of Claims” and “Claim Appendix” sections and other sections as may be required,

2) to vacate the Examiner’s Answer mailed January 16, 2008;

2) to generate a new Examiner’s Answer in response to a corrected Brief and setting forth the correct status of claims and to correct other sections of the Answer as may be required; and

3) and for such further action as may be required.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

KZ/kis

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